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09/687,846	10/13/2000	Cher Esque	3993968-128859	7769

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Porter Wright Morris & Arthur LLP
ATTN Intellectual Property Department
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EXAMINER
LASTRA, DANIEL

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- Th MAILING DATE of this communication appears on th cov r sh t with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ . Responsive to communication(s) filed on <u>07 April 2003</u>.

2a)☐ This action is **FINAL**.　　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

　　a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

1.   Claims 1-20 have been examined. Application 09/687,846 (SOFTWARE AND

METHOD FOR MARKETING ARTISTS) has a filing date 10/13/2000.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Claims 1-20 are not within the technological

arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave

Congress the power to "[p]romote the progress of science and useful arts, by securing

for limited times to authors and inventors the exclusive right to their respective writings

and discoveries".   In carrying out this power, Congress authorized under 35 U.S.C.

§101 a grant of a patent to "[w]hoever invents or discovers any new and useful process,

machine, manufacture, or composition or matter, or any new and useful improvement

thereof."   Therefore, a fundamental premise is that a patent is a statutorily created

vehicle for Congress to confer an exclusive right to the inventors for "inventions" that

promote the progress of "science and the useful arts". The phrase "technological arts"

has been created and used by the courts to offer another view of the term "useful arts".

See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970).   Hence, the first test of

whether an invention is eligible for a patent is to determine if the invention is within the

"technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson,* 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found

that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a

§101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*,

61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, independent claims 1 and 20 recite a "useful, concrete

and tangible result" (a computer program for marketing an artists), however the claims

recite no structural limitations (i.e., computer implementation), and so they fail the first

prong of the test (technological arts).   Dependent claims 2-19 do not remedy this

situation as no structural limitations are recited.

Claim Objections

3.   Claim 17 is objected to because of the following informalities: "invent" should

read "event". Appropriate correction is required.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 1-13 and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated

by Chacker (U.S. 6,578,008).

As per claim 1, Chacker teaches:

A computer program for marketing an artist, the computer program comprising a

main navigational window having a plurality of buttons for opening additional windows,

the plurality of buttons including an artists button and an avenues button, wherein the

artists button opens an artists window having data fields for information relating to

particular artists and the avenues button opens an avenues window having data fields

for information relating to different avenues of marketing (see figures 5-7; column 7,

lines 40-45; column 8, lines 31-40; column 9, lines 30-59; column 10, lines 27-31;

column 11, line 65 – column 12, line 35; column 12, lines 54-64).

As per claim 2, Chacker teaches:

The computer program according to claim 1, wherein the avenues window

provides access to data fields relating to radio, retail, media, and venues (see column 7,

lines 25-50; column 8, lines 30-55; column 9, lines 30-48; column 10, lines 23-49).

As per claim 3, Chacker teaches:

The computer program according to claim 1, wherein the avenues window

includes a radio button for opening a radio window having data fields for information

relating to a radio station, a retail button for opening a retail window having data fields

for information relating to a retail outlet, a media button for opening a media window

having data fields for information relating to media, and a venue button for opening a

venue window having data fields for information relating to a venue (see figures 5-7;

column 7, lines 40-45; column 8, lines 31-40; column 9, lines 30-59; column 10, lines

27-31; column 11, line 65 – column 12, line 35; column 12, lines 54-64).

As per claim 4, Chacker teaches:

The computer program according to claim 1, wherein the artists window provides

access to data fields relating to a particular artist, members associated with the

particular artist, and products associated with a particular artist (see column 9, lines 30-59).

As per claim 5, Chacker teaches:

The computer program according to claim 4, wherein the artists window provides access to data fields relating to tour dates associated with the particular artist, and an itinerary associated with the particular artist (see column 9, lines 54-59; column 12, lines 20-35; column 12, lines 54-62).

As per claim 6, Chacker teaches:

The computer program according to claim 5, wherein the artists window provides access to data fields relating to biographical information associated with the particular artist, and association affiliations associated with the particular artist (see figure 6; column 8, lines 31-55; column 9, lines 30-35; column 12, lines 54-62).

As per claim 7, Chacker teaches:

The computer program according to claim 5, wherein the artists window provides access to data fields relating to notes associated with the particular artist (see column 12, lines 54-63).

As per claim 8, Chacker teaches:

The computer program according to claim 1, wherein the artists window includes an artists tab for opening a window layer having data fields for information relating to a particular artist, a members tab for opening a window layer having data fields for information relating to members associated with the particular artist, and a products tab

for opening a window layer having data fields for information relating to products associated with a particular artist (see column 9, lines 30-59).

As per claim 9, Chacker teaches:

The computer program according to claim 8, wherein the artists window includes a tour dates tab for opening a window layer having data fields for information relating to tour dates associated with the particular artist, and an itinerary tab for opening a window layer having data fields for information relating to an itinerary associated with the particular artist (see column 9, lines 54-59; column 12, lines 20-35; column 12, lines 54-62).

As per claim 10, Chacker teaches:

The computer program according to claim 9, wherein the artists window includes a biography tab for opening a window layer having data fields for information relating to a biography associated with the particular artist, and an affiliations for opening a window layer having data fields for information relating to association affiliations associated with the particular artist (see figure 6; column 8, lines 31-55; column 9, lines 30-35; column 12, lines 54-62).

As per claim 11, Chacker teaches:

The computer program according to claim 9, wherein the artists window includes a notes tab for opening a window layer having data fields for information relating to notes associated with the particular artist (see column 12, lines 54-63).

As per claim 12, Chacker teaches:

The computer program according to claim 1, wherein data fields are provided to store submissions of an artist by name and format (see column 8, lines 30-55).

As per claim 13, Chacker teaches:

The computer program according to claim 12, wherein the format is one of a plurality of predetermined formats (see column 8, lines 30-55).

As per claim 16, Chacker teaches:

The computer program according to claim 1, wherein the plurality of buttons includes an events button and the events button opens an events window having data fields for information relating to particular events (see column 9, lines 54-59; column 12, lines 20-35; column 12, lines 54-62).

As per claim 17, Chacker teaches:

The computer program according to claim 16, wherein the events window includes data fields for an event type for each particular event and the event type is one of a plurality of predetermined event types (see column 9, lines 54-59; column 12, lines 20-35; column 12, lines 54-62).

As per claim 18, Chacker teaches:

The computer program according to claim 16, wherein the events window categorizes event data according to avenues of marketing including radio, retail, media, and venue (see column 9, lines 19-59; column 12, lines 20-35; column 12, lines 54-62).

As per claim 19, Chacker teaches:

The computer program according to claim 1, wherein the plurality of buttons includes a search button and the search button opens a search window having data

fields for information relating to parameters of a search of stored data and the data

fields of the search window are adjusted according to a selected avenue of marketing

including radio, retail, media, and venue (see figure 7; (see column 9, lines 54-59;

column 12, lines 20-35; column 12, lines 54-62; column 13, lines 29-45).

Claim 20 is a composite of claims 1 and 2 therefore the same rejection is applied.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Chacker (U.S. 6,578,008) in view of Haseltine et al (U.S. 6,578,015).

As per claim 14, Chacker fails to teach:

The computer program according to claim 12, wherein stored data can be moved

between active and archived status and data in archived status can be retrieved by

format. However, Haseltine teaches a system where stored data can be moved

between active and archive status and data in archived status can be retrieved or re-

loaded into the active area (see column 7, lines 15-33). Therefore, it would have been

obvious to a person of ordinary skill in the art at the time the application was made, to

know that Chacker would move an artist record between active and archive status, as

taught by Haseltine. This feature would help maintain the information current in the

database. For example, if an artists dies, the system would archive the artist's record

information, so it is no longer active, but if someone needs to access the archive information again, the system would be able to re-load or retrieve the archive record and loaded it into the active area again.

As per claim 15, the computer program according to claim 1, contains the same limitations as claim 14 therefore the same rejection is applied.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Applegate teaches a web company devoted to helping independent musicians distribute and promote their CDs worldwide.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DL

Daniel Lastra
December 7, 2003